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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/658,185 | 09/09/2003 | Paul A. Underbrink | SIRF.P230.US.C1 | 3355 |

7590 01/25/2005
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San Jose, CA 95129

| EXAMINER |
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GELIN, JEAN ALLAND

| ART UNIT | PAPER NUMBER |
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2681

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,185

Applicant(s)

UNDERBRINK, PAUL A.

Examiner

Jean A Gelin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/9/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Krasner (US 5,841,396).

Regarding claim 1, Krasner teaches in figs. 1 and 6 a mobile communications device (20) comprising: an oscillator (39); a communications unit configured to receive communications data from a source, wherein the communications data includes time reference information (i.e., modem 24 receives from source 16 data link which includes time information, figs. 1A-1C); and a global positioning system (GPS) unit coupled to the communications unit, wherein the GPS unit is configured to calibrate the oscillator using the time reference information and to use the oscillator to acquire GPS satellite signals (col. 3, lines 9-14, col. 12, line 46 to col. 13, line 16).

Regarding claim 2, Krasner teaches an automatic frequency control (AFC) element coupled to a communications antenna to receive the time reference information, wherein the time reference information comprises a precision carrier frequency signal, and wherein the AFC is configured to generate a reference signal locked in frequency to the precision carrier frequency signal, wherein the reference signal is used to calibrate the oscillator (col. 3, lines 5-14, col. 12, lines 41-55).

Regarding claim 3, Krasner teaches a phase comparator that receives the reference signal and an oscillator output signal and outputs a control signal that indicates an error in the oscillator output signal (col. 12, lines 56-67).

Regarding claim 4, Krasner teaches a voltage controlled oscillator configured to receive the control signal and to output a GPS clock signal (col. 12, lines 60-67).

Regarding claim 5, Krasner teaches a downconverter that receives the GPS clock signal and a GPS satellite signal and outputs an intermediate frequency signal (col. 14, lines 10-24).

Regarding claim 6, Krasner teaches mobile global positioning system (GPS) device (figs. 6a-6c), comprising: a first antenna (613) for receiving GPS signals (col. 3, lines 2-3, col. 12, line 66 to col. 13, line 1); a downconverter coupled to the first antenna, wherein the first antenna provides the GPS signals to the downconverter, wherein the downconverter includes an input for receiving a GPS clock signal to convert the GPS signals from a first frequency to a second frequency (col. 3, lines 2-3, col. 13, lines 13-14); an oscillator coupled to the downconverter, wherein the oscillator outputs the GPS clock signal (col. 3, lines 3-5, col. 13, lines 10-10, col. 14, lines 17-24); a second antenna (601) for receiving a precision carrier frequency signal from a source (col. 3, lines 5-8, col. 12, lines 42-45); and an automatic frequency control (AFC) circuit coupled to the second antenna to receive the precision carrier frequency signal and configured to generate a reference signal for generating the GPS clock signal (col. 3, lines 9-14, col. 12, line 46 to col. 13, line 16).

Regarding claim 7, Krasner teaches a phase comparator that receives the reference signal and an oscillator output signal and outputs a control signal to the oscillator that indicates an error in the oscillator output signal (col. 12, line 54 to col. 13, line 14).

Regarding claim 8, Krasner teaches a receiver coupled to the second antenna, wherein the receiver receives the precision carrier frequency signal, and further receives a data signal containing satellite data (col. 3, lines 5-14).

Regarding claim 9, Krasner teaches wherein the satellite data includes Doppler data related to a satellite in view of the receiver (col. 5, lines 34-46).

Regarding claim 10, Krasner teaches wherein the satellite data further includes an identification of a plurality of satellites in view of the receiver and a corresponding plurality of Doppler information related to the plurality of satellites (col. 5, lines 3-46).

Regarding claim 11, Krasner teaches wherein the satellite data further includes ephemeris data related to a satellite in view of the receiver (claim 4).

Regarding claim 12, Krasner teaches mobile communications device (figs. 1 and 6), comprising: a GPS antenna for receiving GPS signals (col. 3, lines 2-3, col. 12, line 66 to col. 13, line 1); a downconverter coupled to the GPS antenna, wherein the GPS antenna provides the GPS signals to the downconverter; an oscillator coupled to the downconverter, wherein the oscillator provides an oscillator signal (col. 3, lines 2-3, col. 13, lines 13-60); and a communications unit, including, a communication antenna for receiving a precision carrier frequency signal from a source (col. 3, lines 1-16); and an automatic frequency control (AFC) circuit coupled to the communication antenna,

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wherein the AFC circuit provides a reference signal to calibrate the oscillator signal, wherein the oscillator signal is used to acquire the GPS signals (col. 12, line 56 to col. 13, line 14).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 13-26 are rejected under the judicially created doctrine of double patenting over claims 1-14 of U. S. Patent No. 6,650,879) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A personal communications device comprising: a telecommunications unit comprising a device comprising, a code division multiple access (CDMA) device, wherein the telecommunications unit further comprises a clock source; and a global positioning system (GPS) receiver, wherein the GPS receiver comprises a voltage controlled oscillator for generating a GPS system clock signal

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based upon the clock source, and a feedback loop for controlling the voltage controlled oscillator, wherein the feedback loop comprises, a phase comparator for generating a control signal in accordance with the feedback signal and the clock source; and a loop filter for processing the control signal and outputting the control signal to the voltage controlled oscillator.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A Gelin whose telephone number is (703) 305-4847. The examiner can normally be reached on 9:30 AM to 7:00 PM.

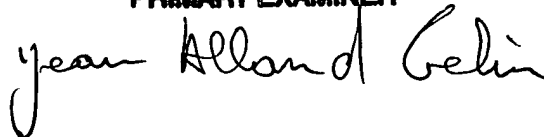
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on (703) 308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JGelin
January 22, 2005

JEAN GELIN
PRIMARY EXAMINER

A handwritten signature in cursive script that reads "jean Allard Gelin". The signature is written in black ink and is positioned below the printed name and title.